

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No.: 09/774,008

REMARKS

Claims 1-9 and 12-16 are pending in the application. By this Amendment, new claim 16 is added.

As a preliminary matter, claim 5 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicant submits that claim 5 complies with § 112, second paragraph.

Claims 1, 2, 5 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Namma *et al.* (U.S. Patent No. 6,185,616; hereinafter “Namma”) view of Aoki (U.S. Patent No. 5,983,090; hereinafter “Aoki”). Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Namma and Aoki, and further in view of Ray *et al.* (U.S. Patent No. 6,067,529; hereinafter “Ray”). Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Namma and Aoki and further in view of “Official Notice.” Claims 7 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Curry *et al.* (U.S. Patent No. 6,359,880; hereinafter “Curry”) in view of Martin *et al.* (U.S. Patent No. 6,614,788; “Martin”). Claims 8, 9, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Voit (U.S. Patent No. 6,075,783; hereinafter “Voit”) in view of Curry. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Voit and Curry and further in view of Menon *et al.* (U.S. Patent Publication No. 2001/0022784; hereinafter “Menon”). Applicant submits the arguments below in traversal of the claim rejections.

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An embodiment of the Applicant's invention relates to a communication system which allows Internet Protocol-based communication between two wireless terminals regardless of whether an IP connection exists in a mobile telephone network.

Rejection of Claims 1, 2, 5, and 13 under § 103(a) over Namma in view of Aoki

Namma discloses proxy server apparatus for providing communication between a network and a server via a public telephone network connected to the server. The proxy server apparatus allows communication between a client terminal and a desired server apparatus.

Aoki discloses a mobile communication system having a function of allowing access to a computer network such as the Internet.

Applicant submits that claim 1 is believed to be patentable because Namma and Aoki fail to teach, suggest, or provide motivation for all elements of the claim. Claim 1 recites:

A method of performing an Internet protocol (IP)-based communication between wireless terminals, the method comprising the steps of:

- (a) *receiving a request for an IP address of a second terminal from a first terminal;*
- (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and
- (c) if the IP address is not registered, *assigning an IP address to the second terminal* corresponding to information from an IP address server.

Applicant submits that Namma and Aoki fail to teach, suggest, or provide motivation for, *inter alia*, "receiving a request for an IP address of a second terminal from a first terminal." In the Office Action, the Examiner states that column 5, lines 1-4 of Namma supposedly discloses receiving a request for an IP address of a second terminal. Namma, however, discloses that the proxy server apparatus receives a communication request for the *server apparatus 4* from the

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client terminal 1. Col. 5, lines 1-6. Unlike what is recited in the claim, Namma or Aoki does not make any mention of a request for an IP address of a second terminal.

Consequently, the combination of the references cannot possibly teach, suggest, or provide motivation for upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server.

Therefore, for at least the above reasons, claim 1 is believed to be patentable.

Claims 2, 5, and 13, which depend from claim 1, are believed to be patentable for at least the reasons submitted for claim 1.

Rejection of Claims 3 and 4 under § 103(a) over Namma and Aoki, and further in view of Ray

Ray discloses a telecommunication method for providing a substantially immediate electronic receipt after a consumer has made a purchase.

Claims 3 and 4, which depend from or ultimately depend from claim 1, are believed to be patentable for at least the reasons submitted for claim 1 and because Ray fails to make up for the deficiencies of claim 1.

In addition, Applicant submits that claim 3 is believed to be patentable because Ray fails to teach, suggest, or provide motivation for sending a notice requesting the second terminal to establish an IP connection if the IP address is not registered. In the sections of Ray cited by the Examiner, the reference merely discloses that a sales terminal 200 instructs the short message sending capable terminal 210 to generate a short message 220 “towards the consumer’s transport

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or alias address.” Col. 4, lines 15-24. The short message is routed through a Gatekeeper 240 which determines if the alias address or transport address is not registered. Col. 4, lines 24-27. If the alias or the transport address is not registered, then the *Gatekeeper 240* can determine the appropriate Gatekeeper 270 the short message is to be sent to and the *Gatekeeper 270* then routes the short message to the appropriate destination terminal 260. Col. 4, lines 41-47 and 58-62. In the above described process, there is nothing to suggest or provide motivation for a step of sending a notice requesting the *second terminal* to establish an IP connection if the IP address is not registered. Rather, Ray discloses that the Gatekeepers 240, 270 establish an IP connection, not the destination terminal 260.

Rejection of Claim 6 under § 103(a) over Namma and Aoki and further in view of “Official Notice”

Applicant submits that claim 6, which ultimately depends from claim 1, is believed to be patentable for at least the reasons submitted for claim 1. Further, Applicant respectfully requests the Examiner to provide prior art which supports his “Official Notice” that transmitting the IP address to said one of a plurality of terminals using transmission control protocol/internet protocol (TCP/IP) or user datagram protocol/internet protocol (UDP/IP), in the context of claim 6, would have been obvious.

Rejection of Claims 7 and 15 under § 103(a) over Curry in view of Martin

Applicant submits that claim 7 is believed to be patentable because Curry in view of Martin fails to teach, suggest, or provide motivation for the recited name server as recited in claim 7. In the Office Action, the Examiner states that the DNS 51 supposedly corresponds to the claimed name server. Curry, however, makes no mention of the DNS 51 as having the

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claimed database for storing IP addresses and the claimed controller which assigns an IP address,  
*in the context of wireless-to-wireless communication.*

Rather, the section of Curry cited by the Examiner as supposedly corresponding to the claimed database of the name server (col. 9, lines 47-54) relates to *PC-initiated communication*, not communication between wireless handsets. Another section of Curry cited by the Examiner as supposedly corresponding to the claimed controller of the name server (col. 18, lines 51-54) relates to the role of the DNS 51 in the context of *wireless handset 1 to PC 21 communication*. Col. 18, lines 20-23. In other words, both of these sections which supposedly disclose the name server make no mention of wireless-to-wireless communication.

Therefore, for at least the above reasons, claim 7 is believed to be patentable and claim 15 is believed to be patentable at least by virtue of its dependency from claim 7.

New claim 16, which depends from claim 7, is believed to be patentable at least by virtue of its dependency from claim 7.

Rejection of Claims 8, 9, and 12 under § 103(a) over Voit in view of Curry

Applicant submits that claim 8 is believed to be patentable because Voit in view of Curry fails to teach, suggest, or provide motivation for a name server in an internet protocol (IP)-based communication system comprising a communication module, a controller, and a database, as claimed.

Applicant submits that the Examiner's generalized allegation that the elements of the computer and associated sets of software modules constitute the controller, database, and communication module is improper. While the features of an apparatus may be recited either

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structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. M.P.E.P. § 2114. Therefore, the Examiner cannot state that the generalized functional descriptions of the Domain Name Server in Voit correspond to the recited claim elements.

Thus, claim 8 is believed to be patentable and claims 9 and 12, which depend from claim 8, are believed to be patentable at least by virtue of their dependency.

Rejection of Claim 14 under § 103(a) over Voit and Curry and further in view of Menon

Claim 14, which depends from claim 8, is patentable at least for the reasons submitted for claim 8 and because Menon fails to make up for the deficiencies of Voit and Curry.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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\*Granted limited recognition under  
37 C.F.R. § 11.9(b), as shown in a copy of  
the same filed on April 12, 2005, at the  
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